

## Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	85388236
LAW OFFICE ASSIGNED	LAW OFFICE 107
MARK SECTION (no change)	
ARGUMENT(S)	
<p>Applicant respectfully requests withdrawal of the Trademark Attorney decision that the mark "PIT BARREL COOKER" is generic. A mark is a generic name if it refers to the class or category of goods and/or services on or in connection with which it is used. <i>In re Dial-A-Mattress Operating Corp.</i>, 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001), citing <i>H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.</i>, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986) ("Marvin Ginn").</p> <p>The test for determining whether a mark is generic is its primary significance to the relevant public. Section 14(3) of the Trademark Act; <i>In re American Fertility Society</i>, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999); <i>Magic Wand Inc. v. RDB Inc.</i>, 940 F.2d 638, 19 USPQ2d 1551 (Fed. Cir. 1991); and <i>H. Marvin Ginn, supra</i>. The USPTO has the burden of establishing by clear evidence that a mark is generic and, thus, unregistrable. <i>In re Merrill Lynch, Pierce, Fenner and Smith, Inc.</i>, 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987). See also <i>In re American Fertility Society, supra</i>; and <i>Magic Wand Inc. v. RDB Inc., supra</i>. "Doubt on the issue of genericness is resolved in favor of the applicant." <i>In re DNI Holdings Ltd.</i>, 77 USPQ2d 1435, 1437 (TTAB 2005).</p> <p>The test for determining whether a mark is generic involves a two-step inquiry. First, what is the genus (category or class) of goods or services at issue? Second, is the term sought to be registered understood by the relevant public primarily to refer to that genus (category or class) of goods or services? <i>H. Marvin Ginn Corporation v. International Association of Fire Chiefs, Inc.</i>, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986).</p> <p>The following are examples of marks that are not generic:</p> <p><b>APPLE RAISIN CRISP</b> <u>General Mills, Inc. v. Kellogg Co.</u> 824 F.2d 622, 39 USPQ2d 1001 (Fed. Cir. 1987).</p>	

USPQ 2d 1442(8 Cir. 1987)

**CALIFORNIA COOLER** California Cooler Inc. v. Loretto Winery, Ltd. 774 F2d 1451, 227 USPQ 808 (9<sup>th</sup> Cir. 1985)

**HONEY BAKED HAM** Schmidt v. Quigg, 609 F. Supp 227, 226 USPQ 518 (E.D. Mich. 1985)

**PARK 'N FLY** Park 'N Fly Inc. v. Park & Fly, Inc. 489 F. Supp. 422, 204 USPQ 204 (D. Mass. 1979)

In this case, there is no showing that the public uses "PIT BARREL COOKER" to refer broadly to barbeque grills. See In re American Fertility Society, 188 F.3d 1341, 51USPQ2d 1832 (Fed. Cir. 1999) (SOCIETY FOR REPRODUCTIVE MEDICINE held not generic for association services because there was no evidence of generic use of the term).

The dictionary definition of "pit" and "barrel" under [www.dictionary.reference.com](http://www.dictionary.reference.com) is as follows:

#### **Pit**

1. A naturally formed or excavated hole or cavity in the ground;
2. A covered or concealed excavation in the ground, serving as a trap.

#### **Barrel**

1. A cylindrical wooden container with slightly bulging sides made of staves hooped together, and with flat parallel ends.

The terms PIT and BARREL used together do not form a generic term or common name for an "old fashioned pit made from a barrel" as set forth by the Attorney. The term "PIT" defines an excavated hole- applicant's goods are not formed in the ground. Further, the examples given by the Trademark Attorney refer to "barbeque pits" and "barrels" but there is no showing of the terms used as a 'PIT BARREL COOKER'. At most the mark is suggestive of the goods offered but it is certainly not generic.

Further, applicant's mark "PIT BARREL COOKER" is a unitary mark. "A mark or portion of a mark is considered "unitary" when it creates a commercial impression separate and apart from any unregistrable component. That is, the elements are so merged together that they cannot be divided to be regarded as separable elements. If the matter that comprises the mark or relevant portion of the mark is unitary, no disclaimer of an element, whether descriptive, generic or otherwise, is required." T.M.E.P. 1213.05.

A phrase qualifies as unitary in the trademark sense only if "the whole is something more than the sum of its parts." Dena Corp. v. Belvedere Int'l, Inc., 950 F.2d 1555, 1561, 21 USPQ2d 1047, 1052 (Fed. Cir. 1991). Even where it includes an otherwise unregistrable component, a unitary phrase as a whole will have "some degree of ingenuity in its phraseology as used in connection with the goods; or [say] something a little different from what might be expected to be said about the product; or [say] an expected thing in an unexpected way." Ex parte Mooresville Mills, Inc., 102 USPQ 440, 441 (Comm'r Pats. 1954) (holding FROM FIBER TO FABRIC FOR THE STYLE CONSCIOUS MILLIONS for fabrics capable of registration on the Supplemental Register).

Applicant respectfully requests reversal of the Trademark attorney's refusal to register Applicant's mark based on genericness.

#### **SIGNATURE SECTION**

<b>RESPONSE SIGNATURE</b>	/ellen reilly/
<b>SIGNATORY'S NAME</b>	Ellen Reilly
<b>SIGNATORY'S POSITION</b>	Attorney of record
<b>SIGNATORY'S PHONE NUMBER</b>	303-839-8700
<b>DATE SIGNED</b>	07/16/2013
<b>AUTHORIZED SIGNATORY</b>	YES
<b>CONCURRENT APPEAL NOTICE FILED</b>	NO

#### **FILING INFORMATION SECTION**

<b>SUBMIT DATE</b>	Tue Jul 16 15:15:28 EDT 2013
<b>TEAS STAMP</b>	USPTO/RFR-75.148.125.33-2 0130716151528041228-85388 236-5001dededcd614ff85431 cffffeef0981b3458b852816da b28fa31b7efc261b729-N/A-N /A-20130716151240616967

### **Request for Reconsideration after Final Action To the Commissioner for Trademarks:**

Application serial no. **85388236** has been amended as follows:

## ARGUMENT(S)

**In response to the substantive refusal(s), please note the following:**

Applicant respectfully requests withdrawal of the Trademark Attorney decision that the mark "PIT BARREL COOKER" is generic. A mark is a generic name if it refers to the class or category of goods and/or services on or in connection with which it is used. *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001), citing *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986) ("Marvin Ginn").

The test for determining whether a mark is generic is its primary significance to the relevant public. Section 14(3) of the Trademark Act; *In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999); *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551 (Fed. Cir. 1991); and *H. Marvin Ginn, supra*. The USPTO has the burden of establishing by clear evidence that a mark is generic and, thus, unregistrable. *In re Merrill Lynch, Pierce, Fenner and Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987). See also *In re American Fertility Society, supra*; and *Magic Wand Inc. v. RDB Inc., supra*. "Doubt on the issue of genericness is resolved in favor of the applicant." *In re DNI Holdings Ltd.*, 77 USPQ2d 1435, 1437 (TTAB 2005).

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The following are examples of marks that are not generic:

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**CALIFORNIA COOLER** California Cooler Inc. v. Loretto Winery, Ltd. 774 F.2d 1451, 227 USPQ 808 (9<sup>th</sup> Cir. 1985)

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refusal to register Applicant's mark based on genericness.

**SIGNATURE(S)**

**Request for Reconsideration Signature**

Signature: /ellen reilly/ Date: 07/16/2013

Signatory's Name: Ellen Reilly

Signatory's Position: Attorney of record

Signatory's Phone Number: 303-839-8700

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is not filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 85388236

Internet Transmission Date: Tue Jul 16 15:15:28 EDT 2013

TEAS Stamp: USPTO/RFR-75.148.125.33-2013071615152804

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